



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
097224,620	12/31/98	MARISETH	42550-82919R

LM21/1217
BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
7TH FLOOR
LOS ANGELES CA 90025

AJVE, G EXAMINER

ART UNIT

PAPER NUMBER

12/17/99

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/224,620

Applicant(s)

Marisethy

Examiner

Glynn Anve

Group Art Unit

2781

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 5/27/99
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-35 and 51-94 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-35 and 51-94 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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DETAILED ACTION

1. This action replaces the action mailed on August 13, 1999. Applicant's preliminary amendment filed on May 27, 1999, was not received in the art unit and entered into the case until August 20, 1999. Because it was filed prior to the mailing of the original action, this action takes the place of the earlier mailed Office action.

Reissue Applications

2. The person who signed the submission establishing ownership interest has failed to state his/her capacity to sign for the corporation or other business entity, and he/she has not been established as being authorized to act on behalf of the assignee. See MPEP § 324.

3. It would be acceptable for a person, other than a recognized officer, to execute a submission establishing ownership interest, provided the record for the application includes a statement that the person is empowered to sign a submission establishing ownership interest and/or act on behalf of the organization.

Accordingly, a new submission establishing ownership interest which includes such a statement above, will be considered to be executed by an appropriate official of the assignee. A separately filed paper referencing the previously filed submission establishing ownership interest and containing a proper empowerment statement would also be acceptable.

4. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

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5. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. The reissue oath/declaration does not specifically indicate what the defects are, how they arose, or when they were discovered. See 37 CFR 1.175 and MPEP § 1414.

6. Claims 1-35 and 51-94 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

7. Claims 51-94 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

In this case, applicant's new claims do not include the "virtual device driver" limitation which the examiner indicated as the allowable subject matter in the parent patent, and which applicant argued as the feature which made the claims allowable over the prior art used in the rejections in the parent application (see applicant's amendment A, pages 5-6, filed 5/28/96 in the parent patent application). Applicant had also added this limitation to claim 11 in order to overcome the art rejection and included it in the claims added in amendment A. The Courts have ruled that such broadening of the claims in a reissue application violates the "recapture rule", see

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Hester Industries Inc. V. Stein Inc., 46 USPQ2d 1641 (Fed. Cir. 1998). Therefore, applicant's claims are rejected as being an improper recapture.

Claim Rejections - 35 USC § 112

8. Claims 51-63, 65-67, 69, 73, 81, and 84-93 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 51 is rejected because it is not clear what is meant by "manages a power level for each of the plurality of devices which in the system and is capable..." on lines 8-10. This part of the claim does not make sense.

Claims 52-63 are rejected because they depend on claim 51.

Claim 65 is rejected because it ends in two periods. This appears to be a simple typo, but it is not certain whether it is or if some other error was made.

Claims 66 and 67 are rejected because they depend on claim 65.

Claim 69 is rejected because it is not clear what is meant by "wherein said power management software responds by updating..." It is not clear what the software is responding to.

Claim 73 is rejected because it includes the trademarked term "Microsoft Windows." The scope of the claim is uncertain since the trademark cannot be used properly to identify any particular material or product. In fact, the value of the trademark would be lost to the extent that it became descriptive of a single product rather than used as an identification of a source or origin

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of a product. Thus the use of the trademark in the claim to identify or describe a product renders the claim indefinite. See Ex parte Simpson, 218 USPQ 1020 (Bd.. App. 1982).

Claim 81 is rejected because it is not clear what is meant by "a device driver for said plurality of devices controls a power state for said plurality of devices performs coordinating and registering." This phrase does not make sense.

Claim 84 is rejected because it depends on claim 81.

Claim 85 is rejected based on lack of positive antecedent basis of "said power management software" on lines 1 and 2-3, and "the system" on line 2.

Claim 86 is rejected because it is not clear what is meant by "...cooperates with said device manager to allow power management said plurality of devices..." on lines 7-8.

Claims 87-93 are rejected because they depend on claim 86.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn Auvé whose telephone number is (703) 305-9638. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh, can be reached on (703) 305-9648. The fax phone number for this Group is (703) 308-9051.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Glenn A. Auvé
December 9, 1999


GLENN A. AUVE
PRIMARY EXAMINER